



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/538,009

06/03/2005

Zvi Feldman

053332-5005

6860

9629 7590 06/23/2008
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

REESE, DAVID C

ART UNIT

PAPER NUMBER

3677

MAIL DATE

DELIVERY MODE

06/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/538,009	Applicant(s) FELDMAN ET AL.	
	Examiner David C. Reese	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 are pending is/are pending in the application.
- 4a) Of the above claim(s) 3,4,13,18-21,23-26,28-30,32,33,35-44 and 47-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 6-12, 14-17, 22, 27, 31, 34, and 45-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

THIS FINAL ACTION IS RESPONSIVE TO THE AMENDMENT FILED 3/3/2008.

- Claims 1-2, 5, 8, 15-16, 45-46 were amended.
- Claims 3-4, 13, 18-21, 23-26, 28-30, 32-33, 35-44, and 47-51 are withdrawn.
- Claims 1-51 are pending.

Claim Objections

[1] Claim 16 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In the instant claim, the limitation of the longitudinal axis being slanted with respect to the second face of the lens has already been claimed in depending claim 1.

Claim Rejections - 35 USC § 112

[2] Applicant has to some degree addressed all rejections under 35 USC § 112 to the Claims in the amendment filed 3/3/2008. Accordingly, the Examiner has not withdrawn the 35 USC § 112 rejections. In particular, claims 5-12 remain rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 5, it is stated that the fastener comprises a lens-face engaging member having a lower and a top surface adapted to engage said head, said member having a through bore coaxial with said bore of the lens. This description apparently describes the ring member (40 of applicant's disclosure) as the fastener, when the fastener has, in depending claim 1, been described as the screw ("...a component engaging portion adapted to engage the fastener

Art Unit: 3677

engaging portion of the component within said bore...”). Note that "a fastener" is singular and cannot be used to describe multiple components. Claims 6-12 are dependent upon claim 5.

Further, as amended:

[3] The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[4] Claims 45-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 45, it is stated that the component comprises “a fastener engaging portion designed for inter-engaging with a fastener entering the bore at said first face and for entering the bore at said second face;” It is unclear to the examiner as to which respective component (fastener-engaging portion, fastener) is entering the bore at either the first or second face. Is this a different embodiment than that claimed in independent claim 1? It is apparent to the examiner that the fastener-engaging portion (26c) enters the bore at the first face and the fastener (30b) enters it at the second face. The same can be said for claim 46; in the preceding claims, it has been claimed that the fastener engaging portion [of the component] enters the bore through the first face with the fastener entering the bore through the second face as opposed to that currently claimed, "...with a fastener entering the bore at said first face...”. Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 102

[5] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[6] Claims 1-2, 6-12, 14-17, 22, 27, 31, 34, and 45-46 are rejected under 35 U.S.C. 102(b) as anticipated by Yoshida, US-6,170,950, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of Yoshida is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 1, Yoshida discloses of a fastening arrangement (see figure 2 and figure below) for use with a curved lens (12) having a first face (2), a second face (1), a bore (14)

Art Unit: 3677

passing between them and a lens axis (3) normal to said second face at the location of the bore, said bore having a longitudinal bore axis (4) which is slanted to said lens axis (4 is slanted relative to 3), the fastening arrangement being adapted for attaching to said lens (12); the component (16) comprising a fastener engaging portion (22); the fastening arrangement comprising a fastener (18) having:

- a lens-face engaging portion (30) adapted to engage (via 72) the second face (2) of the lens (12); and

- a component engaging portion (28) adapted to engage the fastener engaging portion (22) of the component (16) within said bore (14) and to enter the bore at said second face (2), at least when engaged by said fastener engaging portion (22);

- all the engaging portions (30, 28) of the fastener (18) being designed so that, when the component (16), the lens (12), and the fastening arrangement are assembled, the lens-face engaging portion (30) is oriented along said second face (2) of the lens (12).

Art Unit: 3677

Re: Claim 8, wherein said means is in the form of a projection (70) and said component (16) is L-shaped and has a ledge formed with said fastener engaging portion (24) and a leg to support an edge of the lens, said means interfacing (via 24) said leg.

Re: Claim 9, wherein said means (70) is in the form of a projection interfacing with the lens (12).

Re: Claim 10, wherein said lens-face engaging member (72) has a recess in its top surface formed around said through bore and a shoulder (see directly below 30-the ledge supporting the head of the fastener) in said recess surrounding said bore, with which said head (30) of the fastener (18) interfaces.

Re: Claim 11, wherein the shoulder (see directly below 30-the ledge supporting the head of the fastener) is designed such that the longitudinal axis of the stem is parallel to that of the bore.

Re: Claim 12, wherein said recess has a depth greater than the height of the fastener's (18) head (30).

Re: Claim 14, wherein the component engaging portion (70) has a longitudinal axis parallel to the longitudinal axis of the bore.

Re: Claim 15, wherein said component (16) is formed with a plug received within said bore, said plug being formed with a cavity (26) constituting said fastener engaging portion (24) and having a longitudinal axis.

Re: Claim 16, wherein said longitudinal axis (4) is slanted with respect to the second face of the lens (3 is slanted relative to 4).

Re: Claim 17, wherein the component engaging portion (28) of the fastener (18) connects to the fastener engaging portion (24) of the component in a male-to-female configuration, respectively.

Re: Claim 22, wherein the lens (12) has an edge and the component (16) is L-shaped and has a ledge formed with said fastener engaging portion (24) and a leg having a lens-edge interfacing portion.

Re: Claim 27, wherein said component engaging portion (28) of the fastener (18) and the fastener engaging portion (24) of the component (16) are interengageable in a threaded fashion.

Re: Claim 31, wherein the component (16) is a clip of an eyeglass clip-on.

As for Claim 34, Yoshida discloses of an eyeglass assembly comprising a component, a lens and a fastening arrangement as described in claim 1.

As for Claim 45, AS BEST UNDERSTOOD, Yoshida discloses of a component (16) designed for attached to a curved lens (12) having a first face (1), a second face (2), a bore (14) passing between them, and a lens axis (3) normal to said second face (2) at the location of the bore, said bore having a longitudinal bore axis (4) which is slanted to said lens axis (3 is slanted relative to 4); the component (16) comprising:

a fastener engaging portion (24) designed for inter-engaging with a fastener (18) entering the bore at said first face (1) and for entering the bore at said second face (2); and

a longitudinal axis normal to the first face;

the component being designed so that, when the component (16) and the lens (12) are attached, the fastener (18) has an interface oriented along the first face of the lens [if one were to switch around the labeling of the first and second faces].

As for Claim 46, AS BEST UNDERSTOOD, Yoshida discloses component (16) designed for attaching to a curved lens (12) having a first face (1), a second face (2), a bore (14) passing between them and a lens axis normal (3) to said second face (2) at the location of the bore, said bore having a longitudinal bore axis (4) which is slanted to said lens axis (3 is slanted relative to 4); the component (16) comprising:

a fastener engaging portion (24) designed for inter-engaging with a fastener (18) entering the bore at said first face [if one were to switch around the labeling of the first and second faces] and aligning the fastener (18) with the bore; and

first (23a) and second (the end of 24) lens-face engaging portions engageable respectively with said first (1) and second (2) faces so that, when the component (16) and the lens (12) are attached, the lens-face engaging portions (23a, 24) are oriented along the first and second faces of the lens (12).

Response to Arguments

[6] Applicant's amendments and arguments filed 3/3/2008 regarding rejections under 35 U.S.C. 102 have been fully considered but they are not persuasive. First, with regard to applicant's remarks concerning the 112 rejections, the examiner directs the applicant's attention to the beginning of the office action. To reiterate, however, "a fastener" is a singular element and cannot be used to describe multiple components. A fastener would be a screw or a nut, but the combination would be a fastening assembly. The subject matter from claim 5 is delineated toward a different component (the ring) than that of a screw. Properly, the screw and the ring [along with the lens, component, etc.] are considered part of a fastening system or assembly.

Continuing then, with applicant's remarks concerning the prior art of Yoshida, the applicant states that Yoshida does not disclose of a bore having an axis that is slanted to an axis that is normal to the second face at the location of the bore. The examiner disagrees and directs the applicant again above, where a diagram has been provided showing the examiner's interpretation of the prior art of Fig. 14 of Yoshida. It is pertinent to point out that that Applicant is reminded that claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974), and that things clearly shown in reference patent drawings qualify as prior art features, even though unexplained by the specification. *In re Mraz*, 173 USPQ 25 (CCPA 1972). Further, it is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Thus in view of such, and the accompanying diagram above, the examiner maintains that Yoshida does indeed disclose of a bore having an axis (4) which is slanted to an axis (3) that is normal to a second face (2) at the location of the bore (3 is slanted relative to 4).

Conclusion

[7] **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

[8] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached at (571) 272-6987. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Reese

/D. C. R./
Examiner, Art Unit 3677

/Victor Batson/
Supervisory Patent Examiner, Art Unit 3677